UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/543,023	07/22/2005	In Kwon Kim	NOBEL-PCT-US-1	4063

7590   11/29/2007

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EXAMINER
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ART UNIT	PAPER NUMBER
2617	

MAIL DATE	DELIVERY MODE
11/29/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

PTOL-90A (Rev. 04/07)

	Application No.	**Applicant(s)**
Office Action Summary	10/543,023	KIM, IN KWON
	Examiner	**Art Unit**	
	Stephen M. D'Agosta	2617	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
  Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☐ Responsive to communication(s) filed on _____.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) <u>1-5</u> is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) <u>1,4 and 5</u> is/are rejected.

7)☒ Claim(s) <u>2 and 3</u> is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on <u>22 July 2005</u> is/are: a)☒ accepted or b)☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☒ All b)☐ Some * c)☐ None of:

      1.☒ Certified copies of the priority documents have been received.

      2.☐ Certified copies of the priority documents have been received in Application No. _____.

      3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1)☒ Notice of References Cited (PTO-892)

2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3)☐ Information Disclosure Statement(s) (PTO/SB/08)
    Paper No(s)/Mail Date _____.

4)☐ Interview Summary (PTO-413)
    Paper No(s)/Mail Date. _____.

5)☐ Notice of Informal Patent Application

6)☐ Other: _____.

DETAILED ACTION

Claim Objections

Claim 5 objected to because of the following informalities: neither the claim nor the specification defines the term "ARS". It is assumed to be an Automated Response System (?). Appropriate correction is required.

Claim Rejections - 35 USC § 103

Claims 1 and 4-5 rejected under 35 U.S.C. 103(a) as being unpatentable over Rooke et al. US 6,678,361 and further in view of Evans et al. US 2003/0172121 and Fenton et al. US 2003/0193967.

As per **claim 1,** Rooke teaches a method for providing a multimedia messaging service (title/Abstract), comprising the steps of:

(a) connecting a personal terminal of a subscriber with an access function to a MMS server, configuring MMS data, and storing the configured MMS data in a relevant subscriber area of a database (ABSTRACT teaches determining the capability of the phone as well as it's user profile, which reads on the claim:

deciding by said terminal (MS) due to its capabilities (CAP) and *current user profile (UP)* how to handle said received message (MM) ;

(b) if certain data are inputted through a sender's mobile communication terminal and then transmitted to a recipient's mobile communication terminal, reading out, by the MMS server, data from the MMS data previously stored in the subscriber area in step (a), the read data being selected according to whether the recipient's mobile communication terminal supports MMS; and (c) transferring the MMS data read in step (b) and the data inputted through the sender's mobile communication terminal to a mobile communication repeater via a mobile communication company' server to allow the both data to be transmitted to the recipient's mobile communication terminal (For both "a" and "b", Rooke's ABSTRACT teaches an MMS terminal and "server" which can

send/forward messages to the terminal based on the User's profile, which reads on the claim:

The present invention proposes a method for delivering messages in a communication network consisting of at least one terminal and a messaging functionality, said method comprising the steps of <u>receiving a message (MM) for said terminal (MS) by said messaging functionality (MMSC)</u>; sending a notification (MMSNotify) about the presence of said message (MM) from said messaging functionality (MMSC) to said terminal (MS); <u>deciding by said terminal (MS) due to its capabilities (CAP) and current user profile (UP) how to handle said received message (MM)</u>; replying by said terminal (MS) to the notification sent by said messaging functionality (MMSC),

wherein step (b) comprises the steps of:

(b-1) if certain data are requested to be transmitted from the sender's mobile communication terminal to the recipient's mobile communication terminal, providing the MMS server with sender's and recipient's phone numbers and information on the recipient's mobile communication terminal by the mobile communication company's server (Caller ID is inherently well known in the art and will be used, for transmitting phone or receiving phone, to identify the capabilities of both phones so that Rooke's teachings will determine what data, eg. MMS or partial MMS, to send the phone per the ABSTRACT);

(b-2) determining, by the MMS server, whether the recipient's mobile communication terminal supports MMS, based on information on the recipient's mobile communication terminal provided in step (b-1) (Abstract teaches determining capability of the phone, also see figure 2, step 27);

(b-3) if it is determined in step (b-2) that the recipient's mobile communication terminal supports MMS, reading out the MMS data stored in the relevant subscriber area of the database for a sender (ABSTRACT teaches sending MMS data to the phone based on the user capability/profile, also see figure 2, step #210):

therewith instructing according to the result of said decision step; and handling said message (MM) by said messaging functionality (MMSC) according to said instructions;

but is silent on

i) Internet access function,

ii) if it is determined in step (b-2) that the recipient's mobile communication terminal does not support MMS, reading out only SMS data included in the MMS data stored in the relevant subscriber area of the database for the sender.

Evans teaches an MMS phone sending data to a non-MMS compatible phone whereby the message is converted and transmitted to the non-compatible phone (Para's #32-33). Hence an MMS message, or portions of it, will be converted into an SMS message.

Fenton teaches a messaging system that supports many different messaging types and provides service to terminals via various different "core" networks, hence one skilled understands that the user can connect via the INTERNET to send SMS/multimedia messages:

[0025] The present invention provides a flexible architecture that supports <u>present and future multimedia messaging technologies and handles all message types and formats, such as fax, SMS, Multimedia, voice-mail and e-mail, in a consistent manner regardless of message type or format</u>. The present invention also provides consistent access to the system regardless of the access point within the capabilities of networks and terminals. <u>For example, the user can access his or her multimedia messages through a number of different access points, which may include 3G and 2G networks, fixed networks and the Internet</u>. The present invention supports a minimum set of functionality and message media types and message content formats to ensure interoperability between different terminals and networks from the very beginning of service provisioning.

It would have been obvious to one skilled in the art at the time of the invention to modify Rooke, such that it provides **i)** Internet access function, **ii)** if it is determined in step (b-2) that the recipient's mobile communication terminal does not support MMS, reading out only SMS data included in the MMS data stored in the relevant subscriber area of the database for the sender, to provide connectivity via various networks such that a non-compatible MMS terminal can still receive "some" of the MMS message by stripping out (or converting) that portion of the message it can receive (eg. remove multimedia data and send text-only data via SMS).

As per **claim 4,** Rooke teaches any of claims 1 to 3, wherein the personal terminal with the Internet access function is a personal computer, a mobile communication terminal or a personal digital assistant (Rooke teaches mobile devices/terminals).

As per **claim 5,** Rooke teaches claim 1, **but is silent on** further comprising the step of:

(d) connecting a mobile communication terminal with an ARS system, configuring MMS data according to guidance of the ARS system, and storing, by the MMS sever, the configured MMS data in the relevant subscriber area of the database.

The examiner takes **Official Notice** that ARS systems and ARS-like systems (eg. IVR) are well known in the art and prompt a user through a series of steps in order to perform a desired function which can have a huge number of applications, to include voice mail, call centers, call answering, CTI, goods/service ordering, etc..

It would have been obvious to one skilled in the art at the time of the invention to modify the combination, such that it connects a mobile communication terminal with an ARS system, configuring MMS data according to guidance of the ARS system, and storing, by the MMS sever, the configured MMS data in the relevant subscriber area of the database, to provide means for automating the assistance to a user in navigating a complex process of inputting data to the MMS server/database to avoid mistakes which leads to user frustration.

Allowable Subject Matter

Claims 2-3 objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

These claims recite highly specific designs which are not found, either alone or in combination, in the prior art cited.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

1. Skog et al. US 2002/0126708

2. Skog et al. US 6,947,738

3. Swerup et al. US 2002/0078185

4. Aho et al. US 2001/0039589

5. Shaheen et al. US 7035242

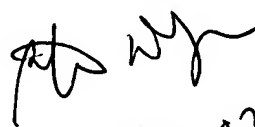6. Ghaffar et al. US 6,978,316

7. Martschitch US 7,020,479

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Stephen M. D'Agosta whose telephone number is 571-272-7862. The examiner can normally be reached on M-F, 8am to 5pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Bill Trost can be reached on 571-272-7872. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

STEVE M. D'AGOSTA
PRIMARY EXAMINER

11-20-07